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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/845,708
Filing Date: April 30, 2001
Appellant(s): CHALLENGER ET AL.

Nathaniel T. Wallace
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/1/2010 appealing from the Office action mailed 1/7/2010.

(1) Real Party in Interest

The examiner has no comment on the statement, or lack of statement, identifying by name the real party in interest in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The following is a list of claims that are rejected and pending in the application:

Claims 16, 17, 19-21, 24, and 32-38.

(4) Status of Amendments After Final

The examiner has no comment on the appellant's statement of the status of amendments after final rejection contained in the brief.

(5) Summary of Claimed Subject Matter

The examiner has no comment on the summary of claimed subject matter contained in the brief.

(6) Grounds of Rejection to be Reviewed on Appeal

Claims 16-17, 19-21, and 32-34 remain, and claims 35-36, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Troyansky (US Pub.# 2003/0190054 A1, 10/9/2003, Provisional application filed on 10/3/2000), in view of Lewis, R., "Adobe Pagemill 2.0 Handbook", hereinafter Pagemill Hayden Books, 1996, pages 138-143, and chapter 1, and further in view of Levy et al, hereinafter Levy (USPub 2003/00112548 A1, 1/16/2003, provisional application filed on 12/21/2000).

Claims 24, and 37 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Troyansky, in view of Pagemill, further in view of Levy, and further in view of Minematsu (Pat.# 6,700,993, 3/2/2004, filed on 9/6/2000).

(7) Claims Appendix

The examiner has no comment on the copy of the appealed claims contained in the Appendix to the appellant's brief.

(8) Evidence Relied Upon

20030190054	TROYANSKY	10-2003
200300112548	LEVY	1-2003
6700993	MINEMATSU	9-2000

Adobe Pagemill 2.0 Handbook”, hereinafter Pagemill Hayden Books, 1996, pages 138-143, and chapter 1.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 16-17, 19-21, and 32-34 remain, and claims 35-36, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Troyansky (US Pub.# 2003/0190054 A1, 10/9/2003, Provisional application filed on 10/3/2000), in view of Lewis, R., “Adobe Pagemill 2.0 Handbook”, hereinafter Pagemill Hayden Books, 1996, pages 138-143, and chapter 1, and further in view of Levy et al, hereinafter Levy (USPub 2003/00112548 A1, 1/16/2003, provisional application filed on 12/21/2000).

Regarding independent claim 16, Troyansky teaches inserting or storing a digital watermark into digital content—*determining a content creation preference*--by replacing or converting parts of digital files, such as HTML files—*electronically encoded HTML textual document*-- with hidden images--*watermarks*--such as image (0003). In other words parts of the text of the HTML files are extracted, and then watermarked by dynamically converting those

HTML parts, which are in a textual format (as is well known, and shown by Pagemill below), into an image.

Furthermore, Troyansky fails to explicitly disclose: *receiving a request for the textual content from a client; obtaining, at a server, the textual content in text format, automatically by the server; replying to the request by serving the HTML document containing the inline reference to the stored textual content in the image format, wherein the reply does not include the textual content in the image format.* However, Pagemill teaches an Internet server receiving a request for a tagged HTML file. In response, the Internet server communicates the HTML file in textual format to a requesting client computer. The images are treated as text by the HTML format (page 12, parag.3-page 13, page 18-20). Levy teaches a server adding, and dynamically linking of a watermarked image, from a database, to a web page at the time of rendering the web page, by adding the link to that image on the web page (0094, last 8 lines)—*generating an HTML containing an inline reference to the stored textual content in the image format for retrieval and dynamic assembly by the client.* It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Troyansky, Pagemill, and, Levy because Troyansky teaches enforcing digital rights of documents, such as HTML by inserting watermarked image files into the document (002-003). Thus, providing the benefit of protecting the obtained HTML document from unauthorized use.

Regarding claim 17, which depends on claim 16, Troyansky teaches inserting a digital watermark into digital content by replacing or converting parts of digital files, such as HTML files, which are in a textual format (as is well known, and shown by Lemay, page 112, lines 15-

36), with hidden images--*watermarks*--such as image (0003). In other words parts of the text of the HTML files are extracted, and then watermarked by dynamically converting those HTML parts into an image.

Regarding claim 19, which depends on claim 16, Troyansky teaches compressing a watermark using lossy compression algorithms--*watermarking preference* (0004, lines 6-9).

Regarding claim 20, which depends on claim 19, Troyansky teaches compressing a watermark using lossy compression algorithms--*compression preference* (0004, lines 6-9).

Regarding claim 21, which depends on claim 16, Troyansky teaches inserting a digital watermark into digital content by replacing parts of digital files, such as HTML files (0003). Troyansky fails to explicitly disclose: *the mapping preference relates selectable spatial display coordinates to external document identifiers in order to enable user navigation*. However, Pagemill teaches inserting an active image, which contains more than one URL. The image is divided into areas, setup by coordinates along with their associated URLs. When a user clicks on an area, the browser jumps to the URL—*external document identifier*-- of the respective area (page 139, lines 21-33, and fig. 6.1). It would have been obvious to a person of ordinary skill in the art at the time of the invention to combine Troyansky, Takashi, Lemay, Truong, and Pagemill, because Troyansky teaches enforcing digital rights of documents, such as HTML by inserting watermarked image files into the document (002-003). Thus, providing the benefit of protecting data in the HTML document from unauthorized use.

Regarding claim 32, which depends on claim 16, Troyansky fails to explicitly disclose: *the content creation preference specifies attributes of the textual content in image format.* However, Levy teaches adding spaces at the end of text in a watermark(0098)—. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Troyansky, and Levy, because Troyansky teaches enforcing digital rights of documents, such as HTML by inserting watermarked image files into the document (002-003). Thus, providing the benefit of protecting the obtained HTML document from unauthorized use.

Regarding claim 33, which depends on claim 16, Troyansky fails to explicitly disclose: *the attributes of the textual content in image format include at least one of font, font size, color, and margins.* However, Levy teaches adding spaces at the end of text in a watermark(0098)—. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Troyansky, and Levy, because Troyansky teaches enforcing digital rights of documents, such as HTML by inserting watermarked image files into the document (002-003). Thus, providing the benefit of protecting the obtained HTML document from unauthorized use.

Regarding claim 34, which depends on claim 16, Troyansky fails to explicitly disclose: *receiving a request from the client, for the textual content in the image format according to the inline reference, wherein the inline reference is a URL, and replying to the request from the client for the textual content in the image format.* However, Pagemill teaches the Internet server communicates the HTML file in textual format to a requesting client computer. The images are treated as text by HTML format (page 12, parag.3-page 13, page 18-

20). The images are loaded from the server after the html text is received and parsed. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Troyansky, Pagemill, and Levy, because Troyansky teaches enforcing digital rights of documents, such as HTML by inserting watermarked image files into the document (002-003). Thus, providing the benefit of protecting the obtained HTML document from unauthorized use.

Regarding independent claim 35, all the limitations are similar to limitations found in claim 16, and therefore are likewise rejected, except for *storing the textual content in the image format as a uniquely addressable element identified by a Uniform Resource Locator (URL)*, which is taught by Pagemill's Internet server receiving a request for a tagged HTML file. In response, the Internet server communicates the HTML file in textual format to a requesting client computer. The images are treated as text by the HTML format, and are referred to by addresses to locations where the images are individually found (page 12, para.3-page 13, page 18-20). Levy teaches a server adding, and dynamically linking of a watermarked image, from a database, to a web page at the time of rendering the web page, by adding the link to that image on the web page (0094, last 8 lines)—*generating an HTML containing an inline reference to the stored textual content in the image format for retrieval and dynamic assembly by the client*. It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Troyansky, Pagemill, and, Levy because Troyansky teaches enforcing digital rights of documents, such as HTML by inserting watermarked image files into the document (002-003). Thus, providing the benefit of protecting the obtained HTML document from unauthorized use.

Claims 36, and 38 are directed towards the steps found in claims 19-20, and therefore are similarly rejected.

Claims 24, and 37 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Troyansky, in view of Pagemill, further in view of Levy, and further in view of Minematsu (Pat.# 6,700,993, 3/2/2004, filed on 9/6/2000).

Regarding claim 24, which depends on claim 19, Troyansky teaches inserting a digital watermark into digital content by replacing or converting parts of digital files, such as HTML files such as image (0003). Troyansky fails to explicitly disclose: *receiving a client system request for verification of the watermarked content*. However, Minematsu teaches a user terminal transmitting first transmission of watermarked information to a detection center, where the information is authenticated. The information is then transmitted to the user terminal, where the authentication result is displayed (col.3, lines 61-col.4, line 67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined Troyansky, Pagemill, Levy, and Minematsu, because Minematsu teaches providing a tamper resistant watermarked image for encrypting information (col. 3, lines 57-67). Thus, providing the benefit of protecting the obtained HTML document from unauthorized use.

Claim 37 is directed towards the steps found in claim 24, and therefore is similarly rejected.

(10) Response to Argument

The Examiner disagrees with appellant's view that Troyansky does not include the conversion of textual content to the textual content in image format, and generating an inline reference to the image (page 6). Troyansky teaches the conversion of text content in an html file into an image (parag.3-4). Although, Troyansky fails to explicitly teach linking the textual content which was converted into an image. However, Levy discloses a server using a watermarked image to automatically place the correct link for the watermark in an html document (0094, spec. last 8 lines). Pagemill (Lewis) teaches the well-known method for sending a webpage file to the client as a text file in html format --The reply does not include the textual content in an image format (page 12, parag.3-page 13 lines 20). It would have been obvious to one of ordinary skill in the art to have a server automatically place a link (as shown by Levy) to the watermarked image version of the text (as shown by Troyansky), and Pagemill, because of all the reasons found in Troyansky such as enforcing digital rights of documents by watermarking portions of the document (0002-0003).

Regarding claim 35, The Examiner also disagrees with appellant's argument that "the combined teachings of Troyansky, Lewis and Levy fail to teach or suggest, "storing the textual content in the image format as a uniquely addressable element identified by a Uniform Resource Locator (URL)" page 8, last parag., because Pagemill's Internet server receives a request for a tagged HTML file. In response, the Internet server communicates the HTML file in textual format to a requesting client computer. The images retrieved over the Web

are treated as text by the HTML format, and are referred to by Internet addresses to locations where the images are individually found (page 12, parag.3-page 13, page 18-20).

Claims 24, and 37 are claims, which depend on the rejected claims above, and therefore are believed to be rejected at least based on the rationale set forth above.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

Conclusion

I. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. 'Welcome to the First WWW Server in Bulgarian with DeleGate and CHILIB, <http://web.archive.org/web/19990221192021/http://baka.aubg.bg/>, 1995., and Sakauchi et al, A Browsing Tool for Multi-lingual Documents for Users without Multilingual Fonts, pages 63-71, ACM, 1996.

For all of the reasons stated above the Examiner believes that the rejections should be sustained.

Respectfully submitted,

/CESAR B PAULA/ Primary Examiner, Art Unit 2178
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September 13, 2010

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